

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: | § | |
| William Thomas Hatfield et al. | § | Group Art Unit: 2612 |
| | § | |
| Serial No.: 10/813,368 | § | Examiner: Davetta Woods Goins |
| | § | |
| Filed: March 30, 2004 | § | Confirmation No.: 4692 |
| | § | |
| For: LIGHTING SYSTEM CONDITION | § | Atty. Docket: 140283-1/YOD |
| MONITORING METHOD AND | § | GERD:0105 |
| SYSTEM | § | |

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| October 22, 2007 | /Patrick S. Yoder/ |
| Date | Patrick S. Yoder |

REPLY BRIEF

This is in response to the Examiner's Answer mailed on August 20, 2007. The Board should reverse the rejections that are subject of this Appellant Review for at least two reasons.

The Examiner has not met the burden of establishing a *prima facie* case of obviousness.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, or under the recent *KSR* decision, *some* reasonable basis, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Secondly, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The basis for the proposed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Although the teaching, suggestion or motivation (TSM) test is no longer the only test available to the Examiner, the Examiner has not established a *prima facie* case of obviousness under this or any other test.

In addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007), reaffirmed many of its precedents relating to obviousness including its holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *KSR*, the Court also reaffirmed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 14. In this regard, the *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 14-15. In *KSR*, the court

noted that the demonstration of a teaching, suggestion, or motivation to combine provides a “helpful insight” in determining whether claimed subject matter is obvious. *KSR*, *slip op.* at 14.

Furthermore, the *KSR* court did not diminish the requirement for objective evidence of obviousness. *Id.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); see also, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on *objective evidence of record*).

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

Importantly, KSR did not reduce or remove the Examiner's burden of establishing a prima facie case.

In the present case, Lange is concerned with monitoring of the light transmissive shield and initiating an automatic current interruption. Jessup discloses a *rupture detector for a windshield assembly* having one or more transparent members, configured to initiate an alarm action in response to a crack in the windshield assembly and raising an alarm. Nesbitt teaches an *anti-vandalism detection and alarm system* and discloses activating a radio to broadcast an alarm report to a reporting device that is remote from the vehicle, where the *alarm report is indicative of an act of vandalism*.

While the Examiner acknowledged that neither Lange nor Jessup discloses the claimed alarm signal being transmitted to a remote location, the Examiner stated that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of providing an alarm upon detection of breakage of lens, as disclosed by Jessup's alarm given upon rupture of glass, as well as providing a communication system that will transmit a signal to a remote location, as disclosed by Nessbitt. However, no reasonable basis, or even a statement of predictable outcome, has been advanced by the Examiner. Nor has the Examiner even attempted to articulate a reasonable likelihood of success of the proposed combination.

As such, the Examiner has clearly not met the burden of establishing a *prima facie* case of obviousness.

It is the Appellants' position that the references cannot be reasonably combined, not that they separately do not teach the elements of the invention.

In the Examiner's Answer, the Examiner indicated that Appellants argued that the references separately do not teach the invention. This is not Appellants' position. Rather,

Appellants would like to reiterate their position that there is *no clear desirability to make the proposed* modification or combination of Lange, Jessup and Nesbitt, and that any purported desirability for transmission of an alarm to a remote location is simply inconsistent with the teachings of Lange and Jessup.

Railroad signaling systems are by their nature remote and generally unmanned. Sensing cracks as claimed, and communicating operational states to a remote location are especially useful. Such monitoring simply did not exist prior to the invention. Indeed, as the references themselves indicate, such monitoring also did not exist in other applications, such as for vehicle headlamps.

The Examiner has failed to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements *in the way* the claimed invention does, without the benefit of hindsight gained from the invention itself.

It is on the combination of the references that the Board should focus in reversing the rejections. The Nesbitt approach to sounding an alarm to combat *vandalism* is not only grossly unnecessary for the Lange headlight crack indicator, which one skilled in the art would liken to low fuel alarms, low tire pressure alarms, door ajar alarms and the like, but in fact is antithetical to the teachings of Lange.

Here again, the Examiner has failed to establish a *prima facie case* of obviousness insomuch as he has failed to show *any* reason for the combination other than the hindsight gained from the invention itself, or any likelihood of success of the combination.

Conclusion

In view of the considerations summarized above, Appellants submit the Examiner has failed to establish *prima facie* obviousness of at least claims 1, 12, 19, 22, 24 and 28. Accordingly, Appellants respectfully submit that independent claims 1, 12, 19, 22, 24 and 28, and claims depending therefrom are allowable and the Appellants respectfully request that the Board overturn the Examiner's rejections.

Respectfully submitted,

Date: October 22, 2007

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